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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/452,135

Applicant(s)

FUJIMOTO, JIJN

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-41 and 43-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-41 and 43-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/22/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Acknowledgments

1. The amendment filed September 22, 2001 (Paper No. 26) is acknowledged. Accordingly, claims 28-41 and 24-55 remain pending.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 22, 2003 (part of Paper No. 26) have been approved by the Examiner.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

4. Claims 28-41 and 43-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Each lettered/numbered paragraph represents a separate rejection:

- a. In claims 28, ~ lines 9-11, it is unclear which information is “recorded on the purchaser rewritable medium as purchaser third data” Since the phrase contains a *single*

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comma, either the first data or the third data could be the data “recorded on the purchaser rewritable medium”

b. Also in claim 28, it is unclear what the additional third data is since lines 20 and 21 states “the third data including additional third data that represents the purchase information for purchasing the first data” If the additional third data is “for purchasing the first data” how can it represent purchasing information? In other words, if the third data or additional third data is *generated by* the “accounting operation that provides the purchaser with the first data,” its impossible for the additional third data to be at the same time “for purchasing the first data” since this would imply that it exists *before* the “accounting operation.”

For example, if the additional data is a transaction number for the sale of first data. It is impossible for this additional data to be “for purchasing the first data” because it doesn’t yet exist.

c. Also in claim 28, Applicant’s latest “Remarks” indicate that “purchaser third data” and “registered third data” differ essentially in location. This is not true because only the ““purchaser third data” includes the “additional third data” making a complete match impossible. Therefore, as claimed, the match need only include a part of (however small) the “purchaser third data” and a part of “registered third data.” If Applicant concurs with this analysis, this particular 35 U.S.C. §112 2nd paragraph rejection will be withdrawn.

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d. In claim 29, the scope of the claim is unclear since it is not known if the recited step is in addition to or in replacement of. See the discussion, *infra*, regarding 35 U.S.C. §112, fourth paragraph.

5. Claim 29 is alternatively rejected under 35 U.S.C. §112, 4th paragraph, as failing to further limit since the dependent claim changes the scope of the dependent claim 29 from that of which it depends (i.e. claim 28). See MPEP §608.01(n) III. Applicant states that the step in claim 29 (the “recording . . . the first data and the additional third data *comprises* recording the purchaser information in the purchaser rewritable medium the purchase information which includes an accounting information representing the accounting operation” Claim 29 could therefore be infringed without infringing claim 28 since claim 29 no longer requires “recording . . . the first data and the third data.” *C.f. e.g.* claim 39 where Applicant now recite “further comprises.”

In other words, it is unclear if the step is *in addition to* the step in claim 28, (i.e. ‘further comprises’) or is in place of (i.e. “comprises”). Because Applicant uses “comprises,” the Examiner interprets the step in claim 29 to be in place of the step recited in claim 28. However a replacement step must *at least* include all previous steps in addition to other steps. Again, see the “Infringement Test” in MPEP §608.01(n) III. Alternatively, the Examiner suggests “further comprises” if the step in claim 29 is intended to be *in addition to* the step in claim 28.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

7. Claims 28-41 and 43-55, as understood by the examiner, are rejected under 35

U.S.C. 102(e) as being anticipated by Suzuki et. al. (U.S. 6,129,274) ("Suzuki '274"). Suzuki

'274 discloses the following: retrieving said third data of said purchaser (Item decryption,

quantity, and price); the third data is registered for every purchaser (every purchaser using the

card for a transaction has an item decryption, quantity, and price); the third data is based on

second data (second data is customer name, address, ect; the items purchased are based upon the

person doing the purchasing); a purchase request is made by a purchaser (who else would make a

purchase request?); performing an accounting operation (totaling the items purchased or noting

which particular item is purchased); the third data is matched (the POS and the card 10 will have

matching information, both will have item description, quantity, and price); first, second, and third

data is recorded on card 10 after the after the information is received; the smart card must be

registered (it must work with the POS system); purchase information includes data specific

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information (unless the information is a copy, its always data specific); and including recording price information (inherent).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et. al. (U.S. 5,267,171)("Suzuki '171") in view of Peterson, Jr. (U.S. 5,857,020)("Peterson"). Suzuki '171 discloses the claimed invention including the first data (the software to be purchased), second data (the ID information on card 20), and third data (LU). Suzuki '171 does not directly disclose placing the first data back on the card. Suzuki '171 instead outputs a floppy disk.

Peterson teaches placing the ID, the purchased data, and other data all on the same medium (e.g. 42). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Suzuki '171 as taught by Peterson outputting the purchased information (first data) back on the same medium. Such a modification would have reduced the number of items a user would have to carry.

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10. Claims 28-41 and 43-55, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki '274.¹ It is the Examiner's principle position that the claimed methods are inherently disclosed. However, if not inherent, the missing elements in Suzuki are only found in the nonfunctional descriptive material and are not functionally involved in the steps claimed (i.e. the steps of "recording price information" as recited in claim 39 is in no way dependent upon the content of the information recorded).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the content of Suzuki '274 with any type of content. The descriptive material will not distinguish the claimed invention over the prior art in terms of patentability because the data does not functionally relate to the steps in the method. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowery*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).²

11. Functional recitation(s) using the word "for" have been given little patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513

¹ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

² See also MPEP §2106 IV B.

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(Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

12. For clarity and due process purposes, the Examiner again notes that Applicant has declined the Examiner's express invitation³ to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. As noted in the previous Office Action on the merits,⁴ the presumption in favor of the ordinary and accustomed meaning is confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997),⁵ and the Examiner continues to rely heavily and extensively on this interpretation.⁶ See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) ("Because the patentee has not chosen to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning") (Clevenger, J. dissenting in part). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles apply to all examined claims currently pending.

³ See the Office Action mailed December 6, 2001, Paper No. 10, Paragraph No. 11.

⁴ See the previous Office Action on the merits mailed June 21, 2002, Paper No. 15, Paragraph No. 11.

⁵ See also MPEP §2111 and §2111.01; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

⁶ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

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Response to Arguments

13. Applicant's arguments regarding Suzuki '274 have been considered but are not persuasive. Applicant specifically argues that Suzuki '274 teaches away from the claimed invention. The Examiner notes that all pending claims have been rejected under 35 U.S.C. §102. "The question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis." *Celeritas Techs. Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998) and *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

Conclusion

14. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

15. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability

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(e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will still require further consideration and/or search and a patentability determination as noted above.

16. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety.

Moreover, because these three references are directed towards beginners (see e.g. “User Level Beginning . . .”), because of the references’ basic content (which is self-evident upon review of the references), and after further review of both the intrinsic evidence of record and the entire art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these three references are primarily directed towards those of low skill in this art. Because these three references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of the knowledge and information contained within these three references.

17. It is the Examiner’s factual determination that all limitations in the pending claims have been considered and are either disclosed or inherent in the references as discussed above.

Furthermore, the inherent features are established by a preponderance of the evidence. *In re*

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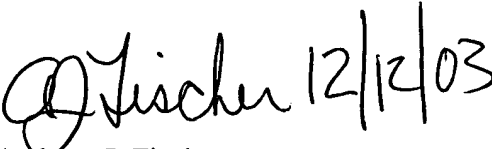
Epstein, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) (“Preponderance of the evidence is the standard that must be met by the PTO in making rejections.” (citations and quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

18. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant disagrees with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,⁷ the Examiner respectfully reminds Applicant to properly traverse the Examiner’s position(s) in accordance with 37 C.F.R. §1.111(b) *in his next response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner’s positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s

⁷ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner’s implied position that the references are analogous art.

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immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. To respond to this Office Action by facsimile, fax to (703) 872-9306.

 12/12/03

Andrew J. Fischer
Patent Examiner

AJF
December 12, 2003